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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,775	02/15/2001	John Wankmueller	AP33001-070457.0972	2264
21003	7590	11/17/2006	EXAMINER KESACK, DANIEL	
BAKER & BOTTS 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498			ART UNIT 3691	PAPER NUMBER

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,775

Applicant(s)

WANKMUELLER, JOHN

Examiner

Dan Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6, 8, and 10 are currently pending. The rejections are as stated below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 31, 2006 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-6, 8, and 10 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Method steps and application code critical

or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Applicant has argued in the remarks filed August 31, 2006, that the invention requires the processing be "in a manner which is independent of the form of the payment card as a chip card or a non-chip card so that the transaction is accomplished for a payment card irregardless of the type its issuer institution's supporting infrastructure." The specification does not enable one of ordinary skill in the art to conduct a transaction according to the claimed "manner". Examiner is unable to determine the steps involved in the claimed "manner", and is unable to locate a description of said "manner" in the specification.

While the specification recites that the transactions are conducted irregardless of the issuer bank's support of chip card technology, it does not describe how a transaction might be conducted "irregardless" of such support. The claims recite that the transactions are conducted in a manner independent of the payment card (chip or non-chip) and irregardless of the support for either card. This requires that the specification be enabling for all combinations, including payment with a chip card using a non-chip card infrastructure and payment with a non-chip card using a chip card infrastructure. The specification is not enabling for these situations, and therefore does not support the claimed subject matter.

Claim Rejections - 35 USC § 102

1. Claims 1 and 3 remain rejected under 35 U.S.C. 102(e) as being anticipated by Paltenghe, U.S. Patent Application Publication No. 2002/0004783. Paltenghe discloses a virtual wallet system including methods and systems of information and financial banking methods utilizing such wallets. Paltenghe teaches a wallet server receiving a signed receipt from the consumer computer, along with a selected payment mechanism, and the wallet server intermediating the payment transaction by sending payment information and authorizations to the merchant server. The server conducts the transaction with the merchant server on behalf of the consumer. Paltenghe further teaches the system uses chip cards along with the wallet server and the merchant server to complete the transaction (See page 6-7, paragraph 71). Paltenghe also teaches a virtual wallet system using non-chip protocols such as Visa credit card, MasterCard credit card etc, as well as chip card compliant technologies such as MasterCard and Visa SET certificates (paragraph 97).

Claim Rejections - 35 USC § 103

2. Claims 2, 4-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe in view of Chaum, U.S. Patent No. 6,434,238.

Paltenghe fails to teach the generation of a cryptogram by the remote wallet server based on secret data shared between the remote wallet server and the issuer institution.

Chaum discloses a multipurpose transaction card system. Chaum teaches the system may be implemented with chip cards or EMV cards, in order to securely transfer data related to financial transactions. Chaum teaches the system where the card issued by an issuing institution communicates with servers which hold account information, the servers containing tamper resistant memory devices which hold secret keys shared between the card and the server for use in secure cryptographic transmission of data (See column 3 lines 41 thru 52). Chaum further teaches the tamper resistant device containing the means for performing authentication of said cryptogram (column 31 lines 37 thru 40). It would have been obvious for one of ordinary skill in the art at the time of the invention to include the cryptographic shared key authentication techniques disclosed in Chaum in the wallet server method disclosed in Paltenghe in order to securely transfer data between servers, as secure transmission is a desirable characteristic of any electronic financial transaction.

3. Claims 1, 3, 6, 8, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., dual use with both chip payment and non-chip payment cards, seamless integration of legacy and new payment technologies) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Specifically, the recitation of claims 1, 3, 6, and 8 that the "transaction is accomplished for the payment card irregardless of its issuer institution having infrastructure to support chip card transactions or having legacy infrastructure supporting only non-chip card transactions" has not been given patentable weight, for the reasons cited above, regarding the claims' indefiniteness.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HANI M. KAZIMI
PRIMARY EXAMINER